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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/775,039

02/09/2004

Kevin P. Parker

PRKR-4600

6907

7590

12/07/2005

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EXAMINER

MACKEY, PATRICK HEWEY

ART UNIT

PAPER NUMBER

3651

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/775,039	PARKER ET AL.	
	Examiner	Art Unit	
	Patrick H. Mackey	3651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 10/13/05 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Fogg. Fogg discloses a device for conditioning an edge of a stack of sheets to be bound that includes a stack clamping mechanism (2); a piercing member (5) with at least one ceramic cutting element (see col. 5, lines 70-75); a positioning mechanism (6); and a drive mechanism (14, 15) with a support member (11) mounted at a first location (12) that reciprocates between a withdrawn position and a piercing position (see col. 4, lines 45-61). The piercing members (5) reciprocate at different points in time (at a first point in time, they all go up, at a second point in time they all go down, they all go up, they all go down) and rotate one after another into the piercing position at different points in time.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 27, 29, and 45 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fogg. Fogg discloses a stack of sheets (See Fig. V). See MPEP § 2113.

6. Claims 27, 29, and 45 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ackley. Ackley discloses a stack of sheets (See Fig. 7). See MPEP § 2113.

Response to Arguments

7. Applicant's arguments filed 10/13/05 have been fully considered but they are not persuasive.

8. The applicant refers to an IDS submitted on May 18, 2005. This IDS is not present in the application.

9. The applicant states that the movement of the cutting teeth of Fogg is not substantially in a piercing plane as claimed. The examiner disagrees with the applicant. If the piercing teeth of Fogg did not move substantially in a piercing plane, they would not pierce the sheets.

10. The applicant states that the Fogg does not disclose planar movement. The examiner disagrees with the applicant. Fogg discloses circular movement in a horizontal plane as well as reciprocal movement in a vertical plane.

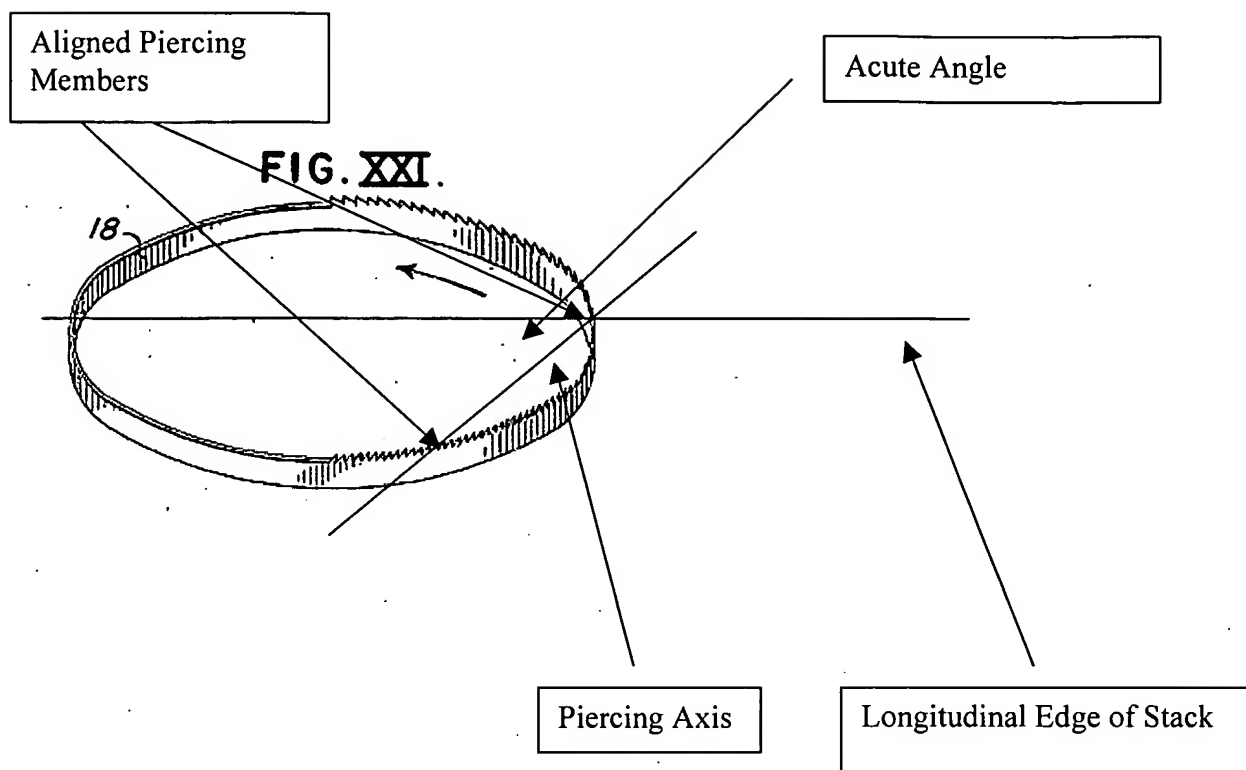
11. The applicant states that Fogg does not disclose that the piercing members are driven to the piercing position at a differing point in time as recited by claim 11. The examiner disagrees with the applicant. Claim 11 states "the drive mechanism is configured to sequentially drive each of the piercing members so that the piercing members arrive at the piercing position at a differing point in time." Fogg discloses that the piercing members (5) reciprocate at different

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points in time (at a first point in time, they all go up, at a second point in time they all go down, they all go up, they all go down) and rotate one after another into the piercing position at different points in time. Each of these movements separately read on claim 11.

12. The applicant states that Fogg does not disclose that the drive mechanism is configured to periodically drive the piercing member into the edge of the stack and away from the edge of the stack a multiplicity of times for each stack as required by claim 30. The examiner disagrees with the applicant. Fogg discloses that the piercing members (5) reciprocate at different points in time (at a first point in time, they all go up, at a second point in time they all go down, they all go up, they all go down) and rotate one after another into the piercing position at different points in time. Fogg reads on the limitation in at least two ways. The piercing members reciprocate into the piercing position at least twice. This reads on the limitation "multiplicity of times". (The applicant could have amended the claim to recite a number more than two, rather than the broad term "multiplicity". This indicates that the scope of the claim includes two). Additionally, the piercing members rotate into and out of the piercing position a multiplicity of times.

13. The applicant states that Fogg does not disclose a piercing mechanism includes a plurality of piercing members including a piercing edge aligned along a piercing axis as recited by claim 37 and 43. The examiner disagrees with the applicant. Fogg discloses that as the piercing members pierce the sheets there will be at least two piercing edges aligned along a piercing axis. Moreover, this axis will not be greater than an acute angle with the longitudinal axis of the sheets. See at least reproduced Fig. XXI below.



14. The applicant states that Fogg does not disclose that the number of reciprocations is dependent upon the thickness of the stack as recited in claim 53. The examiner disagrees with the applicant. Fogg discloses that the piercing member is reciprocated when a stack is present. The movement is dependent on the existence of a stack. If there is a stack, there is a thickness and there is movement. If there is no stack, there is no thickness, and there is no movement.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick H. Mackey whose telephone number is (571) 272-6916. The examiner can normally be reached on Tuesday-Friday 7:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'P. Mackey', with a large, sweeping loop at the end.

Patrick H. Mackey
Primary Examiner
Art Unit 3651

December 2, 2005